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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,423	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.739	5217

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EXAMINER	
BROWN, RUEBEN M	
ART UNIT	PAPER NUMBER
2611	14

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/382,423	PHILYAW, ET AL	
	Examiner	Art Unit	
	Reuben M. Brown	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *14 October 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1,2 and 4-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,2 and 4-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues on 4 that Kikinis does not provide any inducement for the user to activate or access the web. Examiner respectfully disagrees with applicant, and points out that links to be selected may be enhanced, by a special color, halo or outlines, so that the viewer is aware of their presence; see col. 3, lines 27-32 & col. 5, lines 21-27.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis, (U.S. Pat # 5,929,849).

Considering amended claim 1, the claimed method for delivering advertising to a consumer over a broadcast media/global communication network, comprising the steps of generating an advertisement broadcast comprised of a general program and associated advertising dispersed there through for broadcast over a broadcast media which is directed to a general class of consumers, reads on Kikinis which teaches that icons or objects that represent advertisements may be presented to a TV viewer during the display of a particular TV broadcast, (col. 1, lines 5-11; col. 3, lines 10-30 & col. 6, lines 50-65).

The claimed feature of embedding in the broadcast unique information for inducing a consumer to access a desired advertiser's location on the global network over a PC based system reads on Kikinis displaying a particular advertiser's logo or emblem, which is associated with a URL, and interacting with the Internet using a modem, disclosed in Kikinis, (col. 5, lines 49-65; col. 6, lines 51-65 & col. 7, lines 10-14). Also, the additionally claimed feature of broadcasting to the potential class of consumers, the advertisement broadcast with the embedded unique information therein, reads on transmitting the video broadcast along with the URL links which enables the users to access corresponding web pages.

Regarding the amended claimed feature of spreading the unique information throughout the program broadcast at different places, such that the viewer is induced to access the desired advertiser's location after a predetermined time in the broadcast and wherein the location of the unique information in the program broadcast is associated with the content of the program broadcast proximate in time thereto, Kikinis teaches that the URL links may be associated with

specific actors, actresses or the content being currently broadcast; see col. 9, lines 9-24. Kikinis further discloses that for instance, if the broadcast currently is sports programming, sports organizations may desire to advertise season tickets, which clearly reads on the newly added subject matter of associating the unique information with the current content of the broadcast.

As for the information being at predetermined times, since Kikinis teaches that URL data may be multiplexed with the program before it is broadcast, such an arrangement means that the URL data is presented to viewer at predetermined times; see col. 6, lines 32-50.

Considering claim 2, the claimed method step of activating a network or server at the advertiser's location to wait for a response in the form of a network connection to the advertiser's location by a potential consumer, and upon a response from one of the consumers providing information additional to that contained within the advertisement broadcast, reads on the operation of Kikinis, wherein when a user selects an image entity, its corresponding URL is used by the web browser to access web pages at the advertiser's location, see co. 7, lines 57-65 & col. 9, lines 61-67 thru col. 10, lines 1-5. Additional web pages are transmitted to the consumer, in response to requests for the instant web pages, by the well-known process of selection of icons, buttons, interactive images, etc.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Marsh, (U.S. Pat # 5,848,397).

Considering claims 4-5, Kikinis does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kikinis with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Birdwell, (U.S. Pat # 6,108,706).

Considering claims 6-7, Kikinis does not teach the additionally claimed feature, wherein the unique information that is provided at different times in the general broadcast, comprises a first portion for informing the consumer that an access will be available at another desired time and a second portion that is delivered to the consumer at the another desired time for allowing the consumer to access the desired advertiser location.

Nevertheless, Birdwell discloses a system for announcing an upcoming data transmission over a broadcast network, (Abstract, lines 1-10; col. 1, lines 51-57). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kikinis with the technique of announcing upcoming data transmissions, as taught by Birdwell at least for the desirable improvement of informing users in a broadcast environment, so that the user would be able to plan their schedule accordingly.

6. Claims 8 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis, in view of Williams, (U.S. Pat # 6,108,706).

Considering claims 8 & 10, even though Kikinis discusses numerous methods for indicating that a selectable entity is available, (col. 5, lines 20-26) it is does not disclose the use

of audible tones. Nevertheless, the technique of using audible tones in order to inform viewers of the receipt of messages was well known in the art at the time the invention was made, and is taught by Williams, (col. 3, lines 1-10; col. 5, lines 31-35; col. 8, lines 55-64). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kikinis with the technique of utilizing an audible tone to inform the user of the presence of a message, as taught by Williams, at least for the improvement of gaining the user's attention when the user is not actually looking at the display screen.

7. Claims 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis & Williams, and further in view of Marsh.

Considering claims 9 & 11, Kikinis does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kikinis with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Wagner Teaches associating web pages with related TV content, Abstract.

B) Arsenault Teaches that advertisers desire to associate commercial with current TV content.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:
(703) 872-9314, (for formal communications intended for entry)
Or:
(703) 746-6861 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9314 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

ANDREW FAILE
SUPERVISORY PATENT EXAMINER
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